

S/N 09/827,132



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Vicky Sze	Examiner:	Timothy Harbeck
Serial No.:	09/827,132	Group Art Unit:	3628
Filed:	April 3, 2001	Docket:	2043.264US1
Title:	METHOD AND SYSTEM AUTOMATICALLY TO REMIND PARTIES TO A NETWORK-BASED TRANSACTION TO COMPLY WITH OBLIGATIONS ESTABLISHED UNDER A TRANSACTION AGREEMENT		

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated below:

**§103 Rejection of the Claims**

Applicant submits that the Examiner has omitted one or more essential elements needed for a prima facie rejection under 35 U.S.C. § 103. See MPEP § 2143. In particular, the cited references do not teach or suggest all the claim elements of each rejected claim.

Claims 1-35 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Conklin et al. (U.S. 6,141,653, hereinafter "Conklin") in view of Horn et al. (U.S. Publication No. 2001/0037204 A1, hereinafter "Horn").

As conceded to by the Office Action (Pg. 2), Conklin does not disclose, "automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement," as recited in claim 1.

Applicant respectfully disagrees with the Examiner's characterization of Horn to provide the elements missing from Conklin. Horn is directed to an on line system that facilitates confidential and secure exchanges of offers and demands between parties to a dispute. The exchange can take place directly between a claimant and a respondent or their representatives without the involvement of third parties, such as mediators or arbitrators. The system is designed

to minimize overhead costs by automatically reminding the parties of a pending settlement offer at selected time intervals, thereby eliminating the need for constant follow up correspondence and telephone calls. (Abstract)

The Final Office Action of February 13, 2006 (hereinafter "FOA") specifically states Horn teaches the following limitation of claim 1, "presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement." (FOA, pages 2, 3, and 7) It is respectfully submitted, however, that Horn alone or in combination with Conklin does not teach this limitation.

The focus of Horn is dispute resolution where initial obligations may have been made and those very obligations and associated terms are now under dispute with respect to the two parties. Horn facilitates a secure *exchange of offers and demands* between the two parties. (Horn, Paragraph 0017) "...if a party fails to participate in the negotiation process, *the system automatically sends the party reminders of a pending offer* at certain time intervals (e.g., once a week). (Horn, Paragraph 0027) The language of Horn clearly indicates the reminders are for a pending offer and are automatically generated. This is in stark contrast to the recited claim language of a reminder option that is exercisable by a first party. There is nothing in the user interface screenshots of Horn (See, e.g., figures 30-47 and accompanying description) to indicate an exercisable option exists. Simply put, the reminder is sent automatically and Horn does not provide a reminder option.

The FOA has also indicated paragraph 0099 of Horn describes claim 2, which recites, "automatically presenting the reminder option a predetermined time interval after the establishment of the commerce transaction agreement between the first and second parties." However, paragraph 0099 of Horn merely discusses expiration terms of a settlement offer and serves as no basis for describing the presenting of a reminder option for a predetermined time interval. Please compare the text of paragraph 0099 with the claim language and specifically to a "reminder option."

Similarly, the FOA has also indicated paragraph 0027 of Horn describes claim 4, which recites, "automatically disabling the reminder option after the issuance of a predetermined

number of reminders to the second party by exercising of the reminder option by the first party.” However, paragraph 0027 of Horn merely discusses the expiration of a settlement offer (e.g., one month) and does not teach the limitation of the claim recited above. Please compare the text of paragraph 0027, and in particular the last two sentences, with the claim language and a “reminder option.”

Therefore, for at least these reasons, claim 1 and all claims dependent therefrom are patentable over Conklin in view of Horn. The same arguments that applied to claim 1 are also applicable to independent claims 18 and 35, and their associated dependent claims.

Additionally, because of the mischaracterization of a “reminder option” as recited in the present claims, similar arguments as presented with respect to the dependent claims 2 and 4 may also be made with respect to other dependent claims. However, in the interest of brevity and page number compliance in this Pre-Appeal Brief, the Applicant respectfully requests the panel also review and compare the prior art citations of the FOA with the remaining dependent claims.

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**CONCLUSION**

Applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 408-278-4045 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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6/13/2006

By

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**CERTIFICATE UNDER 37 CFR § 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13<sup>th</sup> day of June 2006.

Name: Dawn R. Shaw

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